



**UNITED STATES DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*Sh*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/425,075 10/21/99 CHOUDARY

P 480.97-1-(HV

HANA VERNY  
PETERS VERNY JONES AND BIKSA LLP  
385 SHERMAN AVENUE SUITE 6  
PALO ALTO CA 94306

HM22/0620

EXAMINER

HELMS, L

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

06/20/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
09/425,075

Applicant(s)  
Choudary et al

Examiner  
Larry R. Helms Ph.D.

Art Unit  
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 Jun 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-35 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 1642

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 5/16/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/425075 is acceptable and a CPA has been established. An action on the CPA follows.

2. Claims 1-5, 8-13 and 19-21 have been canceled.

New claims 22-35 which correspond to previous claims 1-5, 8-13 and 19-35, respectively have been added.

Claims 22-35 are under examination.

3. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior Office Action.

4. Given the absence of additional rebuttal to the outstanding rejections of record in applicant's amendment, filed 6/13/01 (Paper #22), and to the amendment not changing the grounds of the previous rejections the rejections are maintained for the reasons of record.

### ***Rejections of Record***

5. The rejection of claims 22-24 and 27-32 under 35 U.S.C. 103(a) as being unpatentable over Horwitz et al (Proc. Natl. Acad. Sci. USA 85:8678-8682, 1988) and further in view of Cregg et al (Developments in Industrial Microbiology 29:33-41, 1988) and The Invitrogen 1997

Art Unit: 1642

Catalog (published 1/97, Yeast expression pages 14-19 and Master Catalog Amendment Notice for pPICZ vectors from 4/15/96) and Sambrook et al (Molecular Cloning, A Laboratory Manual Second Edition pages 1.85, 12.16-12.20, and 13.42-13.44, 1989) is maintained for reasons of record.

6. The rejection of claims 33-35 under 35 U.S.C. 103(a) as being unpatentable over Horwitz et al and further in view of The 1997 Invitrogen Catalog is maintained for reasons of record..

7. The rejection of claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horwitz et al (PNAS 85:8678-8682, 1988) as applied to claims 22-24 above, and further in view of Cregg et al (Developments in Industrial Microbiology 29:33-41, 1988) and The Invitrogen 1997 Catalog (published 1/97, Yeast expression pages 14-19 and Master Catalog Amendment Notice for pPICZ vectors from 4/15/96), Sambrook et al (Molecular Cloning, A Laboratory Manual Second Edition pages 1.85, 12.16-12.20, and 13.42-13.44, 1989) and Vanderlaan et al (U.S. Patent 5,429,925, issued 7/4/95) is maintained for reasons of record..

### ***Conclusion***

8. No claim is allowed.

9. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been

Art Unit: 1642

finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D., whose telephone number is (703) 306-5879. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Art Unit: 1642

11. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-7401.

Respectfully,

Larry R. Helms Ph.D.

703-306-5879

  
SHEELA HUFF  
PRIMARY EXAMINER